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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/976,579 11/24/97 THORNTON

J JAD-34191

EXAMINER

WM31/1002

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ART UNIT

PAPER NUMBER

2131
DATE MAILED:

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10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/976,579

Applicant(s)

THORNTON ET AL.

Examiner

Anthony DiLorenzo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

The request filed on 8/9/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/976,579 is acceptable and a CPA has been established. An action on the CPA follows.

The appropriate sections of Title 35 of the U.S. Code not appearing in this communication have been cited in a previous office action.

Amendments

· Claims

Amendment D, submitted after final rejection on 7/13/01, has been entered. Claims 1, 10, and 19 are amended as requested by Applicant.

Amendment E, submitted with the request for CPA on 8/9/01, has been entered. Claim 28 is added as requested by Applicant.

Claim Rejections

Claim rejections are detailed according to each applicable section of Title 35 of the U. S. Code and to each claim below. Rejections of dependent claims necessarily incorporate the rejections of the base claim and any intervening claims. Information contained in rejections of non-related claims may also be incorporated by explicit reference to them. Similar claims are grouped together.

· Under 35 USC § 102

· · Withdrawn

The rejection of claims 1-3, 5, 6, 8-12, 14, 15, 17-21, 23, 24, 26, and 27 under 35 U.S.C. § 102(b) as being anticipated by Zdybel et al. '686 are withdrawn.

· Under 35 USC § 103

· · Withdrawn

The rejection of claims 4, 7, 13, 16, 22, and 25 under 35 USC § 103(a) as being unpatentable over Zdybel '686 is withdrawn.

· · New

Claims 1-28 are rejected under 35 USC § 103(a) as being unpatentable over Zdybel '686 in view of Durbin '251.

Independent claims 1, 10, 19, and 28:

Zdybel discloses a system and method for transferring digital data via a printed copy. Column 10, lines 13-20 disclose encoding a token (or glyph, as per '686) that relates to another electronic document for the purpose of linking the other document. This is evident because the encoded glyph is disclosed by that section to include a machine readable hypertext pointer values, and hypertext links point to electronic documents. Column 8, lines 38-47 describe the actual

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generation of the tokens. Lines 47-50 of that same column disclose printing the encoded glyphs onto a paper document. Zdybel does not disclose that the printed tokens are user-selectable, or means for selecting one or more of the tokens from a list.

- 5 In the context of claims 1, 10, and 19, wherein the list is not explicitly claimed to be a list of scanned-in tokens, but instead can also be interpreted as a list of printed tokens, the broadest reasonable interpretation of “means for selecting” in the art includes any scanning means that can scan individual tokens, or any system that can select among tokens that are already scanned. In the context of claim 28, wherein the list is explicitly generated after the tokens are scanned, the
10 broadest reasonable interpretation of “token selector” is any system that can select among tokens that are already scanned.

Durbin ‘251 discloses an indicia reader that can handle multiple indicia (col. 3, ll. 10-15). Referring to col. 4, ll. 23-61, the user can point a scanner at a surface containing multiple printed
15 indicia and the scanner will perform a low resolution scan of the surface, encoding that data and displaying it on a screen for the user. This display is read on the claim limitation of a list of tokens, under the interpretation that the tokens are already scanned, because the display can show the user more than one token at a time as per col. 4, ll. 56-61. Col. 5, ll. 41-55 confirm that the intended scope of Durbin is to allow the user to select and access one token from a list of tokens.

20 The person of ordinary skill in the art would be motivated to use the reading and selection means and methods of Durbin to implement the scanning processes of Zdybel. Motivation to combine the references comes from both the Durbin and Zdybel references. Durbin recognizes the importance of being able to decode a single token on a page containing many adjacent codes, and
25 provides such an invention for doing so, even if the scan area cannot be adjusted to scan only a particular token (col. 5, ll. 51-55). The Zdybel reference depicts a document with multiple adjacent tokens in figure 4. The person of ordinary skill in the art would recognize the usefulness of the means and methods of Durbin for decoding the document depicted in figure 4 of Zdybel and would be motivated to implement them in order to obtain the advantages of
30 Durbin as described above. In this combination a user would be able to individually select which tokens to access in Zdybel by pointing a scanner at the page and moving the scanner so that the desired token is highlighted while utilizing only technology that currently exists in the art.

Claims 2, 11, and 20:

35 Zdybel discloses an electronic scanner for reading the encoded tokens in, for example, column 9, lines 46-53.

Claims 3, 12, and 21:

40 Zdybel column 9, lines 41-45 and 53+ disclose that the token is recognized by a workstation (i.e., information is recovered from the glyph). A processor is inherent for performing this step.

Claims 4, 13, and 22:

Zdybel does not explicitly or implicitly disclose the actual retrieval of an electronic document based on the printed, recognized tokens. However, there is clear motivation in the Zdybel patent

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for the person of ordinary skill to include this step in the practicing of that invention. Column 10, lines 13-20 disclose encoding a pointer to an electronic document in the token. Column 3, lines 54-60 disclose, as shortcoming of the prior art in document hard copies, that printed documents often do not include the links provided by the pointers contained in their corresponding electronic forms. The person of ordinary skill, given the fact that the Zdybel patent does explicitly disclose including a hypertext pointer in a token, would be motivated to use said pointer to retrieve the electronic document it references.

Claims 5, 14, and 23:

Zdybel figure 4 discloses the printing of a human readable identifier (element 45) relating to a token printed on the paper document. See associated text in column 10, lines 40-50.

Claims 6, 15, and 24:

A memory/storage means for storing the generated tokens is inherent in the Zdybel patent as per figure 5.

Claims 7, 16, and 25:

Zdybel does not explicitly disclose encoding data in a token relating to the owner of the document. This feature would be obvious to the person of ordinary skill given the disclosure that is present in that invention. Column 4, line 64 through column 5, line 2 disclose that the tokens may be used to encode meta-data about the document itself, such as file name, creation/modification dates, access/security information, and printing histories. Motivation to include information relating to the owner as part of this meta-data comes from the Zdybel reference itself, as per column 4, lines 16-19, wherein Zdybel states as background that fundamental attributes of an electronic document, such as the author (owner), are seldom included in the hard copy representation of the document. As Zdybel recognized this as a shortcoming of the prior art, and provides a system that can correct that shortcoming, the person of ordinary skill would have sufficient motivation to include information relating to the owner of a document in the token of Zdybel.

Claims 8, 17, and 26:

Encryption of the encoded tokens of Zdybel is disclosed in claim 17 of that patent.

Claims 9, 18, and 27:

Zdybel discloses encoding of authentication information in column 5, lines 2-6.

Response to Remarks

Applicant's remarks traversing the rejections applied in the final action of May 22, 2001 have been considered. As those rejections have been withdrawn, the remarks are considered to be moot in view of the new grounds of rejection, which cite prior art disclosing means for selecting tokens.

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Conclusion

The following prior art made of record but not previously cited is considered pertinent to the applicant's disclosure:

- 5 1. Durbin '773 discloses further prior art methods for selecting tokens from a list.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony DiLorenzo, whose telephone number is (703) 306-5617. If the examiner is not available, a voice mail greeting will indicate when the examiner will return to the office. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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20 September 28, 2001


9/28/01